

Application No. 10/502,504
In Reply to Office Communications dated July 20, 2006
and November 9, 2006
Paper dated November 20, 2006
Attorney Docket No. 0470-044735

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 1700

REMARKS

Applicants acknowledge receipt of the Advisory Action dated November 9, 2006, and the explanation of the continued rejection therein. Receipt of the Advisory Action helpfully clarifies for Applicants the issue from the Examiner's perspective as of the time of the Advisory Action. Applicants in turn believe that the below resolves the issue as state and any remaining concerns.

As the Examiner well appreciates, in chemical practice a species invention is patentable over a genus if and when new and unexpected results are obtained with the species (subset) invention *vis a vis* a more generic disclosure in the prior art (see *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) and *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991)), especially when that generic prior art disclosure is internally contradictory. In this case, Applicants are not claiming a dry cleaning composition or its use in which a surfactant may optionally remain undissolved (which is what the prior art suggests, by the way)—the present invention is the method of using a fluid dry cleaning solution containing densified carbon dioxide in which at least 10% of the ionic surfactant is—affirmatively—present specifically in an **undissolved** form. Because Romack et al. disclose and teach that (as ably summarized by the Examiner) the disclosed surfactant may be either dissolved in or partially undissolved in the dry cleaning composition, this means that according to Romack et al. **either** dissolved or undissolved surfactant may be present. However, according to the present invention, the claim affirmatively requires the presence of at least 10% **undissolved** surfactant. The inability of Romack et al. to teach the inventive new and unexpected results is particularly highlighted in that Romack et al. advocate the use of a co-solvent to ensure that

Application No. 10/502,504
In Reply to Office Communications dated July 20, 2006
and November 9, 2006
Paper dated November 20, 2006
Attorney Docket No. 0470-044735

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 1700

carbon-dioxide-insoluble surfactants may be used—clearly implying the undesirability of undissolved surfactant, not unexpected benefits associated with it.

Any concern, therefore, that the Romack et al. generic disclosure somehow makes obvious the present affirmative recitation of at least 10% undissolved surfactant (whereas in Romack et al. the undissolved surfactant not only need not but ought not be present) should be satisfied from the standpoint of an analogous “on-off” understanding. If the presence or absence of undissolved surfactant in Romack et al. is regarded as a conceptual “on-off” situation--undissolved surfactant may be present (“on”) but should not be present (“off”) and both “on” and “off” are disclosed by Romack et al.--then the generic disclosure of Romack et al. of either “on” and “off” does not teach the present claim in which the undissolved surfactant must always be “on” and can never be “off” (i.e., at least 10% undissolved surfactant must be present). The “on-off” genus does not teach the “on” species, because absent consultation of the present specification one does not know the affirmative new and unexpected results possible when the undissolved surfactant is required to be present. Moreover, the new and unexpected results attributed to the present invention as claimed are not unsupported allegations or conclusions. Data supporting “dramatically improved cleaning performance” is presented in the table on page 15 of the specification, which summarizes the results of twelve examples conducted to illustrate the advantages of the claimed invention and the criticality of the presence of the undissolved surfactant. No expert’s declaration is needed in this prosecution because the unexpected results data in the specification are already so extensive.

The above explanation may be seen as distinguishable from the facts in, for example, In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976), relied on by the

Application No. 10/502,504
In Reply to Office Communications dated July 20, 2006
and November 9, 2006
Paper dated November 20, 2006
Attorney Docket No. 0470-044735

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 1700

Examiner, as follows. In In re Lamberti, the Board explained that a prior art disclosure of a compound where the R-S-R portion had "at least one methylene group attached to the sulfur atom" implied that the other R group attached to the sulfur atom could be other than methylene and therefore suggested asymmetric dialkyl moieties. Applicants understand that in some instances, such as In re Lamberti, certain generic disclosures can make a species obvious to one skilled in the art. The difference between the In re Lamberti prior art and the present facts, however, is that Romack et al disclose the contradictory opposites—that undissolved surfactant may be present or not present—and the two opposites, being completely inconsistent, cannot suggest the criticality of one or the other. In other words, Romack et al. cannot, by disclosing both opposites, teach or suggest that one or the other would give new and unexpected results—particularly when Romack et al. emphasize the importance of **avoiding** undissolved surfactant in their composition, which is the exact opposite conclusion of the present invention in which undissolved surfactant **must** be present.

Application No. 10/502,504
In Reply to Office Communications dated July 20, 2006
and November 9, 2006
Paper dated November 20, 2006
Attorney Docket No. 0470-044735

**Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 1700**

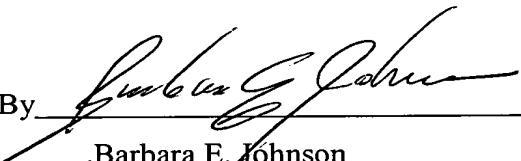
CONCLUSION

In view of the above illustration of how Romack et al. cannot make obvious the present invention, due to the internal inconsistency of its teachings which thus cannot be extrapolated to reach the present invention, allowance of pending claims 11-15 and 17-21 is respectfully requested. Applicants also request entry of the Response filed October 20, 2006.

Respectfully submitted,

THE WEBB LAW FIRM

By



Barbara E. Johnson
Registration No. 31,198
Attorney for Applicants
700 Koppers Building
436 Seventh Avenue
Pittsburgh, Pennsylvania 15219
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com